

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of : James Alexander Sharpe
Serial No. : 10/518,307
Filed : September 26, 2005
For : TREATMENT OF TISSUE SPECIMENS
Examiner : Brenda A. Lamb
Art Unit : 1792
Customer number : 23644
Confirmation No. 6671

RESPONSE TO FINAL OFFICE ACTION DATED AUGUST 20, 2008

Honorable Director of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This response is being filed in view of the Examiner's further and final Office Action of August 20, 2008. No amendments are being made since, as will become apparent from the discussion below, none are believed appropriate.

In the Office Action, the Examiner has rejected claims 1-2 and 7 under 35 U.S.C. §102 as being anticipated by Kling U.S. Patent No. 2,583,379, and the Examiner has further rejected claims 1-2 and 7 under 35 U.S.C. §102 as being anticipated by Mans U.S. Patent No. 3,062,225. The remaining dependent claims have been rejected on the basis of obviousness under 35 U.S.C. §103, with one or the other of the secondary references being cited, as well. Reconsideration is requested.

Turning first to Kling, it would seem that the Examiner has rejected applicant's argument that Kling does not disclose a trough for identical treatment of specimens,

because the Examiner considers that applicant's argument is not commensurate with the open ended language of claim 1. Claim 1 does have open ended language, in that it comprises a first structure providing a chamber for holding the liquid and comprises a second structure including holding means. However, claim 1 explicitly states that the chamber is in the form of an annular trough, and that the specimens depend from the holding means at angularly spaced positions around a circle, and that the second structure includes a lid which acts to close the annular trough chamber.

Therefore, while further structures may be present, claim 1 is expressly limited to the first structure comprising an annular trough. Applicant's novelty and non-obviousness arguments are not dependent on applicant's arguing that applicant's claim relates to a single trough and a single lid, as this seems irrelevant, given that Kling discloses nothing which can be considered to be an annular trough.

Claim 1 is therefore not anticipated by Kling as Kling discloses no chamber which can be described as an annular trough. Kling discloses a series of cylindrical chambers which are axially spaced in a circle. An annular trough is quite a specific structure, requiring an elongate open ended chamber which elongate chamber is circular in nature in order to form an annulus. It is this nature of trough which allows more than one specimen to be brought into contact with the same liquid, providing the advantages of the invention.

It is also submitted that claim 1 is non-obvious in view of Kling essentially for the same reasons as set out in response of April 30, 2008, which bear repeating here.

The claims distinguish over Kling, and the remainder of the prior art, in at least three ways:

- 1) the chamber is in the form of an annular trough.
- 2) the holding means hold the specimens so that the latter depend from the holding means at angularly spaced positions around the circle.
- 3) the second structure includes a lid which acts to close the chamber in the first position and the other side of which carries the holding means.

It is submitted that claim 1, and its depending claims, clearly distinguish from the prior art. The invention has the advantage of simplicity and low maintenance resulting from the provision of a common trough, so that all the specimens are identically treated, i.e. they are all dipped into the same liquid for exactly the same time. Also, the provision of a common lid closes the single chamber in the most effective way, and the feature of the underside of the lid carrying the holding means for supporting the specimens provides the simplest way of supporting the specimens and insuring that the trough is closed when the specimens are moved into the liquid.

Kling discloses immersion apparatus for subjecting tissue specimens to a plurality of treatments. The tissue specimens are treated successively in a plurality of liquid agents held in a number of angularly spaced beakers 54. Each beaker is closable by an individual lid 62. There is one beaker for each specimen to be treated and one covering lid for each beaker. By this means, the tissues are successively treated in a plurality of liquid agents. This contrasts with the present invention as set forth in claim 1, where the object is to subject all specimens to an identical treatment by dipping them into the same liquid held in a common container for exactly the same time of treatment.

The examiner has also argued that claim 1 is anticipated by Mans (US 3,062,225). It would seem that the examiner considers that chamber 6 in Mans constitutes an annular trough as required by claim 1. As can be seen from Figure 2 of Mans, container 6 is divided into compartments 24 which each constitute small containers and are described as being considered to be in an annular formation although they do not comprise a complete annulus.

It is therefore apparent that the separate compartments 24 disclosed in Mans are showing essentially the same arrangement as in Kling, whereby a plurality of separate containers are arranged in a circular pattern. There is no disclosure of an annular trough in Mans, as none of the containers are sufficiently elongate for them to be described as a trough. If enough individual containers 24 are considered together, then they form an annular structure, but then the resulting series of individual containers is not a trough, as it contains partitions. The whole purpose of having a trough is that the contents of the trough is the same throughout, ensuring

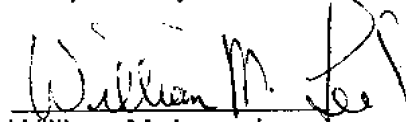
that the specimens, when inserted in the trough, are exposed to the same material for the same duration. The structure in Mans does not provide this advantage. Applicant therefore submits that claim 1 is novel and non-obvious in view of Mans, essentially for the same reasons as for Kling.

It is therefore submitted that claim 1 distinguishes from, and is allowable over, the prior art. The remaining claims depend from claim 1, and are therefore submitted to be allowable, as well. As a result, the secondary references cited by the Examiner are not discussed as issues concerning those references are moot.

The Examiner's further and favorable reconsideration of the application is therefore urged.

October 16, 2008

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William M. Lee, Jr.", is written over a horizontal line.

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